APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,513	12/11/2003	Carl J. Kraenzel	LOT920030060US1	9245

45544   7590   04/15/2009
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EXAMINER
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ART UNIT	PAPER NUMBER
2195	

NOTIFICATION DATE	DELIVERY MODE
04/15/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 March 2009</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,2,6-12 and 27-36</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,2,6-12 and 27-36</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>12/11/03</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

1.   Claims 1-2, 6-12, and 27-36 are presented for examination.

2.   This final action is in response to the RCE/Amendment/Remarks on 3/10/09. Applicant's

arguments were fully considered but are moot in view of the new grounds of rejections prompted

by the Applicant's amendment to the claims.

Specification

3.   The title of the invention is not descriptive. A new title is required that is clearly

indicative of the invention to which the claims are directed. This objection for a more

descriptive title has been made in the previous office action. However, the Applicant has not

responded to this objection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

4.   **Claims 27-36 are directed to non-statutory subject matter.**

5.   As to claim 27, it is directed to a universal user roaming system that could be interpreted

to one of ordinary skill in the art as software, per se. The universal user roaming system that the

claim is directed to comprises of a code development system, a storage setting system, and an

export system, which all could be interpreted to one of ordinary skill in the art as software, per

se. Claims directed to software, per se fail to fall under one of the four statutory categories of

inventions under 35 USC 101 (see MPEP 2106). Therefore, claim 27 is found to be non-statutory.

6.   As to claim 32, it is directed to a recordable medium that is non-statutory. One of ordinary skilled in the art could interpret the recordable medium to include memory and the Specification discloses that memory may comprise transmission media that can be distributed across a plurality of physical systems in various forms (see page 8, paragraph [0017]). This type of transmission refers to data signals, carrier waves, etc., which are non-statutory subject matter. Therefore, claim 32 is found to be non-statutory.

7.   Claims 28-31 are also found to be non-statutory as they depend on claim 27 and do not cure its deficiencies.

8.   Claims 33-36 are also found to be non-statutory as they depend on claim 32 and do not cure its deficiencies.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   **Claims 1-2, 8-10, 27-29, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burger et al. (hereinafter Burger) (US 2003/0220876 A1) in view of Deng et al. (hereinafter Deng) (US 2006/0168395 A1), and further in view of Clark et al. (hereinafter Clark) (US 6,317,797 B2).**

10.   *Burger and Deng were cited in previous office actions.*

11.   As to claim 1, Burger teaches a universal user roaming method, comprising:

providing a computer program having a first set of program code executable on a first

WIN32-based operating system (first distinct codes) and a second set of program code

executable on a second non-WIN32-based operating system (second distinct codes, PALM OS or

Microsoft Windows CE, etc.) (see Abstract, lines 6-13, page 9, [0118], page 10, [0127]);

setting the first set of program code and the second set of program code to read and write

from a common datastore (read/write memory 210 can store first and second distinct codes and

may have instructions stored therein which, when executed by the controller, cause

implementation of routines/software) (see Abstract, lines 6-13, page 10, [0127]); and

12.   In summary of the above citations, an embodiment of Burger teaches a portable

electronic device 102, referred to as a "Pocket Vault". The Pocket Vault is a hand-held device

like a personal digital assistant (PDA), such as a Palm Pilot, and has an operating system such as

Palm OS (or Microsoft CE, depending on the PDA). The Pocket Vault can communicate

information with one or more plurality of personal desktop computers. The Palm OS or

Microsoft CE are operating systems for a PDA and not for a desktop computer, and Burger (page

2, [0014]) clearly shows that the computer and the electronic device are distinct from each other.

For the desktop computers to perform any type of processing, an operating system is required in

each of the computers, and these operating systems of the desktop computers are not Palm OS or

Microsoft CE but rather an operating system related to a computer (not a PDA device).

Read/write Memory 210 can store first and second distinct codes and may have instructions

stored therein which, when executed by the controller, cause implementation of

routines/software. Therefore, the read/write memory 210 is equivalent to the claimed datastore.

13.   However, Burger is silent in storing the content of the common datastore on a removable

storage medium that is accessible to only one of the operating systems at any one time, wherein

the first set of program code and the second set of program code provide the operating system

functionality to perform common operations on the common datastore. Deng discloses the use

of flash memory (or USB Flash Drive, mobile hard disk, semiconductor mobile storage device,

zip disk and the like), for example, as a common datastore that is a removable storage medium

that is accessible to only one computer/operating system (Windows or non-Windows based) at

any one time ([0017]-[0018], [0020]-[0021]). In addition, Deng discloses a universal system

interface which interprets and performs the corresponding operations according to commands

based on the data from the flash storage device (Abstract, [0032]-[0034]). One of ordinary skill

in the art would have known to modify the memory of Burger's apparatus such that it would

have a removable storage medium similar to Deng's flash storage memory that is accessible to

only one operating system at any one time and serving as a universal system interface which

interprets and performs the corresponding operations according to commands based on the data

from the flash storage device. The suggestion/motivation for doing so would have been to

provide the predicted result of improving the convenience to the user from using memory that is

removable and mobile (see last lines of Abstract, [0003], [0007]).

14.   Furthermore, Burger in view of Deng is explicitly silent in teaching the first set of

program code being a version of an application that is adapted for execution on the first WIN32-

based operating system, the second set of program code being a different version of the

application that is adapted for execution on the first WIN32-based operating system, and

executing the application from the removable storage medium. However, Clark teaches the use

of Microsoft Windows based standard desktop or notebook computer systems along with small

handheld computer systems, wherein the small handheld devices perform a reduced/simplified

(different) version of the desktop computer application (col. 2, lines 41-50, col. 10, lines 17-19

and 35-37, col. 11, lines 3-7 and 15-21 and 27-49). In addition, Clark teaches that flash memory

114 can be utilized by both the desktop and handheld computers as a removable storage medium

that directly provides functionality to execute certain functions generally utilized on the road,

such as minimal data entry recalculation of spreadsheets, simple editing of word processing

without extensive macro capabilities, and so on (lines 1-4 of the Abstract and col. 11, lines 1-11

and 25-29, see Fig. 5, item 114).   Finally, there is a common file (common datastore) utilized

between the handheld and desktop computer systems for coordination (see Title and col. 16, lines

50-53, col. 11, lines 15-49). One of ordinary skill in the art would have known to modify Burger

in view of Deng's system and method such that it would include the features of the first set of

program code being a version of an application that is adapted for execution on the first WIN32-

based operating system, the second set of program code being a different version of the

application that is adapted for execution on the first WIN32-based operating system, and

executing the application from the removable storage medium, as taught in Clark. The

suggestion/motivation for doing so would have been to provide the predicted result of avoiding

synchronization difficulties as well as reducing storage requirements (col. 2, lines 42-50 and col. 11, lines 3-7). Therefore, it would have been obvious to one of ordinary skill in the art to combine Burger, Deng, and Clark to obtain the invention of claim 1.

15.   As to claim 2, Clark teaches wherein the first operating system is an operating system for a computer system selected from the group consisting of a desktop (desktop computer) and a laptop (notebook computer) (col. 1, lines 15-18 and 49, col. 2, lines 1-27).

16.   As to claim 8, it is rejected for the same reasons as stated in the rejection of claim 1.

17.   As to claim 9, it is rejected for the same reasons as stated in the rejection of claim 2.

18.   As to claim 10, Burger (see Abstract, lines 6-13) and Clark (col. 16, lines 50-53) teach wherein the first set of program code and the second set of program code are provided within a common directory.

19.   As to claim 27, it is rejected for the same reasons as stated in the rejection of claim 1.

20.   As to claim 28-29, they are rejected for the same reasons as stated in the rejections of

claims 9-10, respectively.

21.   As to claim 32, it is rejected for the same reasons as stated in the rejection of claim 1.

22.   As to claim 33-34, they are rejected for the same reasons as stated in the rejections of

claims 9-10, respectively.

23.   Claims 6-7, 11-12, 30-31, and 35-36 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Burger et al. (hereinafter Burger) (US 2003/0220876 A1) in view of Deng

et al. (hereinafter Deng) (US 2006/0168395 A1), in view of Clark et al. (hereinafter Clark)

(US 6,317,797 B2), and further in view of McGuffin (US 7,010,651 B2).

24.   Burger, Deng, and McGuffin were cited in previous office actions.

25.   As to claim 6, Deng teaches the method of claim 1, wherein the removable storage

medium is a USB flash microdrive or a Zip drive ([0020]). However, Burger and Deng are silent

in teaching specifically that other options of removable storage that could be used are an SD-

RAM card and a read-writeable compact disc. McGuffin teaches incorporating removable

memory storage that could include magnetic removable storage (e.g., floppy disks, cassette

tapes, zip drives, USB hard drives and microdrives; optical removable storage (e.g., CD-R, CD-

RW, DVDs, etc.); and solid state removable storage, or devices that have no moving parts (e.g.,

multimedia cards, memory sticks, SmartMedia cards, CompactFlash and Secure Digital cards)

(col. 2, lines 22-38). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Burger in view of Deng to include all the options of using

removable storage such as in McGuffin. The suggestion/motivation would have been to provide

storage that is preferably easily removable in nature to best facilitate extraction of data stored on

the medium for use in other computer systems (col. 2, lines 31-37). Therefore, more options of

convenient removable media provide more choices for a user to determine what is most

preferable and convenient for him or her.

26.   As to claim 7, Deng ([0020]) and McGuffin (col. 2, lines 22-38) teach wherein the SD-

RAM interfaces with a computer system via a USB adapter.

27.   As to claims 11-12, they are rejected for the same reasons as stated in the rejections of

claims 6-7, respectively.

28.   As to claim 30-31, they are rejected for the same reasons as stated in the rejections of

claims 11-12, respectively.

29.   As to claim 35-36, they are rejected for the same reasons as stated in the rejections of

claims 11-12, respectively.

Response to Arguments

30.   Applicant failed to respond to the objection of the Title in the previous office action and

is reminded to amend the Title such that it is clearly indicative of the invention to which the

claims are directed.

31.   Applicant argues with respects to independent claims 1, 8, 27, and 32 that the references

cited by the Office do not teach or suggest the newly amended claim limitations of storing

multiple versions of an application tailored for particular device on a removable storage device

with a common datastore and executing the application from the removable storage device to

perform operations on the datastore when the removable storage device is coupled with the

appropriate device (see Remarks, pages 9-10).

        In response, Applicant's arguments have been fully considered. However, the newly

amended claim limitations prompted the new grounds of rejections that render the argument

moot. Applicant is referred to the new grounds of rejections made above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- **Chiu (US 2003/0104833 A1)** discloses a common data store between a Handheld electronic device 1 and a Desktop Computer 2 (See Abstract and Fig. 1);

- **Bodnar et al. (US 6,915,312 B2)** discloses a common data storage/medium between a desktop/laptop computer and a hand-held device (col. 3, lines 48-58).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENNETH TANG whose telephone number is (571)272-3772. The examiner can normally be reached on 8:30AM - 6:00PM, Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth Tang/
Examiner, Art Unit 2195